

REMARKS/ARGUMENTS

Claims 1-23 are pending in this application. Claims 1, 8, and 15 are independent claims.

Claim Rejections – 35 USC § 103(a)

Claims 1-5, 7-12, and 14-23 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Baker et al. (“Baker”, U.S. Patent Number 6,185,627) and Boston Acoustic, Inc. (“Boston Acoustic”, press release), and Porrazzo et al. (“Porrazzo”, U.S. Patent Number 5,872,855) and Chan (“Chan”, U.S. Patent Number 6,600,908). Claims 6, 13, and 20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Baker and Boston Acoustic, and Porrazzo and Chan and in further view of Shdema et al. (“Shdema”, U.S. Published Patent Application 2002/0072816). Applicant respectfully traverses these rejections.

“To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.” (emphasis added) (MPEP § 2143). If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

As the Patent Office is aware, obviousness cannot be established by combining the teaching of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under 35 U.S.C. § 103, teachings of references can be combined only if there is some suggestion or incentive to do so. *ACS Hosp. Sys., Inc. v. Montefiore Hosp.*, 732 F.2d 1572, 221 USPQ 929 (Fed. Cir. 1984). Thus, the Patent Office may not use the patent application as a basis for the motivation to combine or modify the prior art to arrive at the claimed invention.

The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. It is impermissible to use the claimed invention as an instruction manual or ‘template’ to piece together the teachings of the prior art so that the claimed

invention is rendered obvious. This court has previously stated that “[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.” (emphasis added) *In re Oetiker*, 977 F.2d 1443, 24 USPQ 2d 1443 (Fed. Cir. 1992) quoting *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ 2d 1596, 1600 (Fed. Cir. 1988).

In rejecting independent Claims 1, 8, and 15, the Patent Office first admitted that none of Baker, Boston Acoustics, and Porrazzo “expressly teach a multiplexer or switch for changing said speaker input from the analog signal to a digital to analog converter when digital audio is detected.” (Office Action, Page 2). Then, the Patent Office proceeded to use the present claimed invention as an instruction manual or “template” to piece together the teachings of the prior art. This is clearly evidenced when the Patent Office indicated that “[s]o, detecting a digital or analog signal is well known in the art. What is needed is a system that has a switch from said speaker input to the analog signal from the digital to analog converter.” (emphasis added) (Office Action, Page 3, Lines 1-3). By doing this, the Patent Office has *impermissibly* used the present patent application as a basis for the motivation to combine or modify the prior art to arrive at the claimed invention.

The Patent Office has alleged that Boston Acoustic provides the required motivation by indicating that Chan “would have been motivated to implement the automatic feature because it would provide the user with easy to set up, connect, and control the listening flexibility of the speaker system. (*Boston Acoustic, Inc.*, pg. 2).” (emphasis added) (Office Action, Page 3). However, Boston Acoustics teaches that “[s]mall and compact, Unity is a sleek, one-body home theatre system that is easy to set up, connect and control. The speaker package is designed to compliment the majority of today’s televisions.” (emphasis added) (Boston Acoustics, Page 2). Therefore, Boston Acoustics teaches an easy to set up, connect and control one-body home theatre system, not an easy to set up, connect and control speaker system. Accordingly, Boston Acoustic fails to provide the motivation for Chan to implement the automatic feature.

Thus, in rejecting independent Claims 1, 8, and 15, the Patent Office has selected portions from four references (i.e., Baker, Boston Acoustic, Porrazzo, and Chan) to arrive at the present invention, in which, none of the references supply the

motivation for the additional reference as proposed. Rather, the references are relied upon for selected elements, but the desirability of the elements in the combination has not been supplied absent the present application. Since the references do not supply the desirability of the modification, it is respectfully submitted that a *prima facie* case of obviousness for independent Claims 1, 8, and 15 has not been established. Therefore, independent Claims 1, 8, and 15 should be allowed.

Dependent Claims 2-7, 9-14, and 16-23 depend from Claims 1, 8, and 15, respectively, and therefore should be allowed.

CONCLUSION

In light of the foregoing, Applicant respectfully requests that a timely Notice of Allowance be issued in the case.

Respectfully submitted on behalf of
Gateway, Inc.,

Dated: November 20, 2003

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